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EXAMINER

BASHORE, WILLIAM L

ART UNIT

PAPER NUMBER

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ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte UMESH GOPALDAS KHATWANI
and THEODORE JACK LONDON SHRADER

Application 09/579,256
Technology Center 2100

Mailed: January 15, 2009

Before KAREN SWEENEY, *Paralegal Specialist*.
SWEENEY, *Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL

This application was electronically received by the Board of Patent Appeals and Interferences on June 17, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

FINAL REJECTION

The Final Rejection filed October 5, 2006 states claims 1-7, 9-17, 19-25, 27-37, and 39-70 are rejected. However, a review of the file reveals that claims 49 and 50 are not mentioned in the Final Rejection. On page 2 and 6, the Final Rejection states:

Claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 are rejected under 35 U.S.C. 102(e) as being unpatentable over Imielinski et al., [page 2]

Claims 1-7, 9-12, 17, 25, 32-37, 39-48, 51, 52, 56, 59-65, and 67-70 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Imielinski et al., Batres [page 6]

The Appeal Brief mailed June 20, 2007 under the heading “Status of Claims” states:

Claims pending: 1-7, 9-17, 19-25, 27-37, and 39-70 [page 4]

In addition, under the headings of “Grounds of Rejection to be Reviewed on Appeal and Argument” states:

. . . .claims 13-16, 19-24, 27-31, 53-55, 57-58, and 66 are obvious under 35 U.S.C. § 103(a) over *Imielinski* et al. . . . [page 17, 18-25]

. . . . claims 1-7, 9-12, 17, 25, 32-37, 39-48, 51-52, 56, 59-65, and 67-70 are obvious under 35 U.S.C. § 103(a) over *Imielinski* et al . . . and further in view of *Batres*. . . . [page 17, 18-25]

The Examiners Answer mailed October 5, 2007 under the heading “Grounds of Rejection” states:

Claims 13-16, 19-24, 27-31, 53-55, 57, 58, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imielinski et al. . . . [page 4]

Claims 1-7, 9-12, 17, 25, 32-37, 39-48, 51, 52, 56, 59-65, and 67-70 remain rejected under 35 U.S.C. 103(a) as being over Imielinski et al. . . . further in view of Batres. . . . [page 8]

Clarification of claims 49 and 50 is required.

APPEAL BRIEF

On June 20, 2007, Appellants filed an Appeal Brief. A review of the file reveals that the “Summary of Claimed Subject Matter” does not map each of the dependent claims 49-52, 54-59 and 61-63 to the Specification. Appellants must provide support for the “means” for language, as set forth in 37 C.F.R. § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Proper correction of the Appeal Brief is required.

When the Office holds the brief to be defective solely due to appellant’s failure to provided a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v), an entire new brief need not, and should not be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) Clarify claims 49 and 50;
- 2) to hold the Appeal Brief filed on August 6, 2007, defective;
- 3) notify Appellants to file a paper providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v), and properly addressing claims 49-52, 54-59 and 61-63;
- 4) consider the Paper, and if necessary vacate the Examiner's Answer and supply a new Examiner's Answer in response to the Summary of the Claimed Subject matter as required by 37 C.F.R. § 41.37(c)(1)(v); and
- 5) for such further action as may be deemed appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

KIS

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